

In view of the foregoing, it is respectfully submitted that the objections to the drawings have been obviated, and withdrawal of these objections is therefore respectfully requested.

**III. Objection to the Specification**

The Specification was objected to because the Abstract exceeded 150 words. As indicated above, the Specification has been amended herein to replace the current Abstract with a new Abstract having less than 150 words. No new matter has been added. It is respectfully submitted that the objection to the Specification has been obviated, and withdrawal of this objection is therefore respectfully requested.

**IV. Objection to the Claims**

The claims were objected to on the basis of certain informalities. Specifically, claim 4 was objected to because the Examiner maintains that the word "hatch" should read –hash-. Claim 4 has been amended in accordance with the Examiner's suggestion. Thus, it is respectfully submitted that the objection to the claims has been obviated, and withdrawal of this objection is therefore respectfully requested.

**V. Rejection of Claims 1 to 9 Under 35 U.S.C. § 102(b)**

Claims 1 to 9 were rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,251,382 ("Hellar"). Applicants respectfully submit that Heller does not anticipate the present claims for the following reasons.

Claim 1 relates to a measuring device that includes a first edge defining a first region. Claim 1 recites that the first region has a first set of indicia corresponding to a first linear scale, the first linear scale being actual. Claim 1 also recites that the measuring device includes a second edge defining a second region, the second region having a second set of indicia corresponding to a second linear scale. Claim 1 recites that the second linear scale is non-actual. Claim 1 has been amended to recite that a non-actual dimension determined by the second edge in the second linear scale corresponds directly to an actual dimension determined by the first edge in the first linear scale.

Hellar purport to relate to a measuring tape that provides for quick determination of the center of a distance without requiring the calculation of the distance. Heller states that the measuring tape includes two parallel edges and an ascending measuring scale along each edge printed on the same face of the tape and beginning at the same end of the tape. Heller also states that one of the scales has units calibrated to a conventional unit of length measurement. According to Heller, the second measuring scale has units calibrated to be exactly half the unit of the first scale.

With respect to claim 1, the Office Action maintains that "Hellar teaches a measuring device (1) comprising: a first edge (3) defining a first region, said first region having a first set of indicia (9) corresponding to a first linear scale; a second edge (2) defining a second region, said second region having a second set of indicia (8) corresponding to a second linear scale, wherein said second linear scale is non-actual (Col 2, lines 46-52 and lines 61-67)." Office Action at page 3.

It is respectfully submitted that Heller fail to disclose, or even suggest, a measuring device that includes a first, actual, linear scale, and a second, non-actual, linear scale such that a non-actual dimension determined in the second linear scale corresponds directly to an actual dimension determined in the first linear scale, as recited in claim 1. The present invention describes at page 14, lines 6 to 18 of the Specification that:

"... instead of using a conventional ruler to measure the length of the wall on the drawing ... and then performing a conversion to determine the length of the wall in actuality, the numerical values 26b of device 10 clearly show the user that the length of the wall as shown on the drawing is [, e.g.,] 20 feet, because the indicia 22b of region 20b have numerical values 26b that correspond to the scaled distance. The need for performing a conversion step is thereby eliminated. Upon determining the distance shown on the drawing, the user can then use the indicia 22a of measuring device 10 corresponding to the actual linear scale to position the wall in actuality." (emphasis added).

Thus, amended claim 1 provides a single measuring device that can determine corresponding measurements in both a first, actual, linear scale and a second, non-actual, linear scale, enabling a user to measure, e.g., a dimension on a drawing drawn

to scale, and to make a corresponding actual measurement. In contrast, Hellar describes a tape measure that determines a centerpoint of a distance. Thus, the two dimensions determined by the tape measure of Hellar, a first dimension and a second dimension that is equal to half of the first dimension, do not directly correspond to each, but are intended to be different dimensions.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Hellar does not disclose, or even suggest, a measuring device that includes a first, actual, linear scale, and a second, non-actual, linear scale such that a non-actual dimension determined in the second linear scale corresponds directly to an actual dimension determined in the first linear scale, as recited in amended claim 1.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the reference relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art.” See M.P.E.P. § 2112; emphasis in original; and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App.

& Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

In summary, it is respectfully submitted that Heller do not anticipate claim 1.

As for claims 2 to 9, which ultimately depend from claim 1, it is respectfully submitted that Heller do not anticipate these dependent claims for at least the same reasons given above in support of the patentability of claim 1.

#### **VI. Rejection of Claims 1, 10 and 11 Under 35 U.S.C. § 102(b)**

Claims 1, 10 and 11 were rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 1,085,905 ("Hagey"). Applicants respectfully submit that Hagey does not anticipate the present claims for the following reasons.

Hagey purports to disclose a system for gaging cylindrical measures. In support of the present rejection, the Office Action states that "Hagey teaches a measuring device (A, B) comprising: a first edge (Fig. 1) defining a first region, said first region having a first set of indicia (a) corresponding to a first linear scale; a second edge (Fig. 1) defining a second region, said second region having a second set of indicia (b) corresponding to a second linear scale, wherein said second linear scale is non-actual." Office Action at p. 4.

It is respectfully submitted that Hagey does not anticipate claim 1 for at least the reason that Hagey does not disclose, or even suggest, all of the features recited in claim 1. For example, Hagey fails to disclose, or even suggest, a measuring device that includes a first, actual, linear scale, and a second, non-actual, linear scale such that a non-actual dimension determined in the second linear scale corresponds directly to an actual dimension determined in the first linear scale, as recited in claim 1. Rather, Hagey describes a device "for rapidly ascertaining correct dimensions for cylindrical measures," col. 1, lines 19 to 22. Specifically, the device may be used to measure a peck or a bushel. Thus, the two measurements determined by the device of Hagey, a first measurement of a distance and a second measurement of a peck or a bushel, do not directly correspond to each, but are intended to be different.

Therefore, for at least the reasons stated above, it is respectfully submitted that Hagey does not anticipate claim 1.

As for claims 10 and 11, which ultimately depend from claim 1, it is respectfully submitted that Hagey does not anticipate these dependent claims for at least the same reasons given above in support of the patentability of claim 1.

**VII. Rejection of Claim 12 Under 35 U.S.C. § 102(b)**

Claim 12 was rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 4,484,395 ("Samuels"). Applicants respectfully submit that Samuels does not anticipate the present claims for the following reasons.

Claim 12 relates to a method for measuring that includes the step of positioning a measuring device on a drawing, the measuring device having a first set of indicia corresponding to a first linear scale and a second set of indicia corresponding to a second linear scale, wherein the drawing has features sized in the second linear scale. Claim 12 also recites that the method includes the step of, using the second set of indicia, determining a first length measurement of a feature on the drawing. Claim 12 also recites that the method includes the step of, using the first set of indicia, determining a second length measurement on an object, wherein the first length measurement and the second length measurement correspond to the same actual dimension.

In support of the present rejection, the Office Action states that "Samuel teaches a method for measuring, comprising the steps of: positioning a measuring device on a drawing (Col. 1, lines 5-24), said measuring device (10) having a first set of indicia (9) corresponding to a first linear scale and a second set of indicia (8) corresponding to a second linear scale, wherein said drawing has features sized in a second linear scale (Col 1, lines 5-24); using said second set of indicia, determining a first length of measurement of a feature on said drawing (Col 1, lines 5-24); using said first set of indicia, determining a second length measurement on an object, wherein said first length measurement and said second length measurement correspond to the same actual dimension (Col 7-17 and lines 40-57)." Office Action at pp. 4 to 5.

Samuels purports to disclose a scale for use in making direct measurements in feet and inches on blue prints and the like drawn in various reduced scales. Samuels states that the scale features special inch character markings throughout the length of the scale to enable the user to directly read measurements in inches between corresponding foot measurements. Samuels further states that the markings include 3, 6 and 9 inch subdivision and character markings with 6 inch markings for the smallest scale contemplated.

It is respectfully submitted that Samuel does not anticipate claim 12 for at least the reason that Samuels does not disclose, or even suggest, all of the features recited in claim 12. For example, Samuels fails to disclose, or even suggest, a method for measuring that includes the steps of determining a first length measurement of a feature on a drawing using a device having a second, non-actual, linear scale and determining a second length measurement on an object using a first, actual, linear scale, wherein the first length measurement and the second length measurement correspond to the same actual dimension, as recited in claim 12. Rather, Samuels describes a blue print scale that has various non-actual linear scale, each having inch markings therebetween. Specifically, Samuels states that "it is an object of the present invention to provide such a reduced measuring scale in which such effort is not required by the user to alleviate the source of errors and to facilitate the making of direct measurements on reduced scale drawings as described." Col. 1, lines 43 to 47. Thus, any two measurements determined by the device of Samuels are both non-actual.

Therefore, for at least the reasons stated above, it is respectfully submitted that Samuels does not anticipate claim 12.

### **VIII. Conclusion**

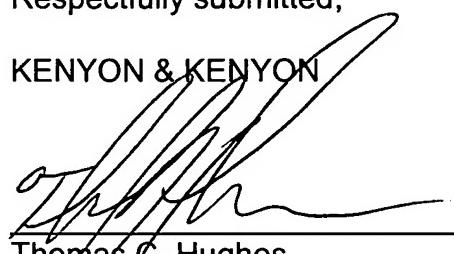
Attached hereto is a marked-up version of the changes made to the Specification and claims by the current Amendment. The attached page is captioned "Version with Markings to Show Changes Made."

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

By:

  
Thomas C. Hughes  
Reg. No. 42,674

One Broadway  
New York, New York 10004  
(212) 425-7200

**CUSTOMER NO. 26646**



**26646**

PATENT TRADEMARK OFFICE

**Version with Markings to Show Changes Made**

**IN THE SPECIFICATION:**

The Abstract has been deleted without prejudice and replaced with the following new Abstract:

--A measuring device, such as a ruler, tape measure, etc. includes a first edge having a first set of indicia corresponding to a first linear scale, and a second edge having a second set of indicia corresponding to a second linear scale. The first linear scale may be actual, while the second linear scale may be non-actual, such as a linear scale employed on an engineering or architectural drawing. The indicia of the second linear scale are spaced apart and labeled with numerical values that correspond to the scaled distance between the indicia, and therefore provide an indication of the actual length of an object upon measurement of the length of a corresponding feature on a drawing drawn to scale.--.

**IN THE CLAIMS:**

Claim 2 has been cancelled without prejudice.

Claims 1 and 4 have been amended without prejudice as follows:

1. (Amended) A measuring device comprising:

a first edge defining a first region, said first region having a first set of indicia corresponding to a first linear scale, wherein said first linear scale is actual;

a second edge defining a second region, said second region having a second set of indicia corresponding to a second linear scale, wherein said second linear scale is non-actual, such that a non-actual dimension determined by the second edge in the second linear scale corresponds directly to an actual dimension determined by the first edge in the first linear scale.

4. (Amended) The device of claim 1, wherein each indicia of said first and second sets of indicia comprise a [hatch] hash mark and a numerical value.



1/3

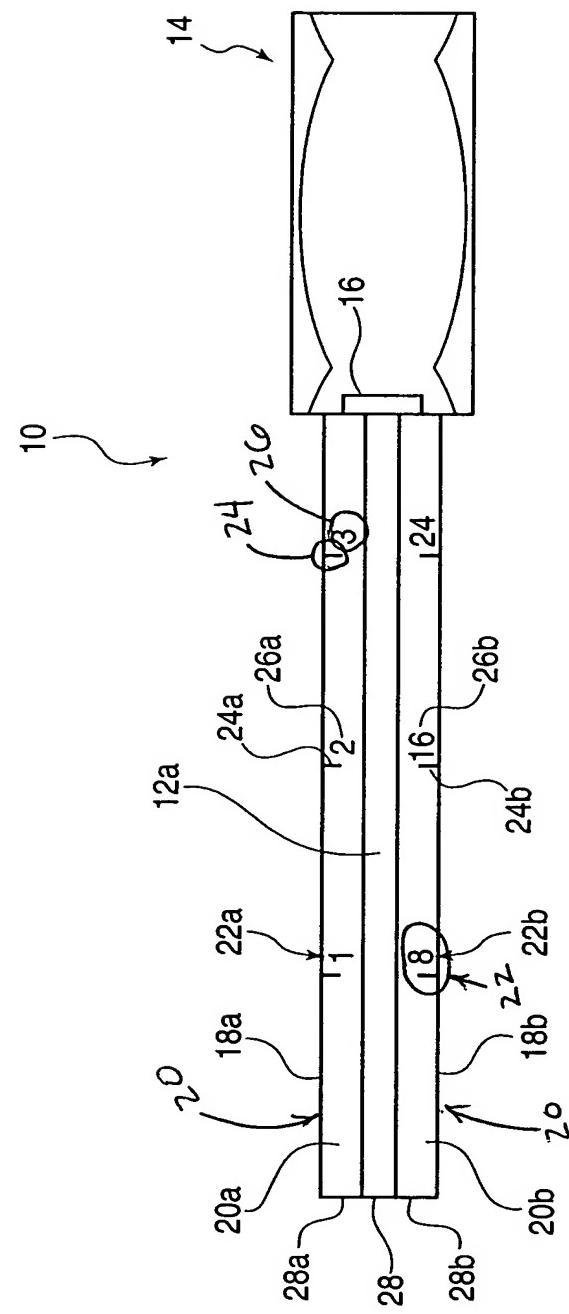


Fig. 1



2/3

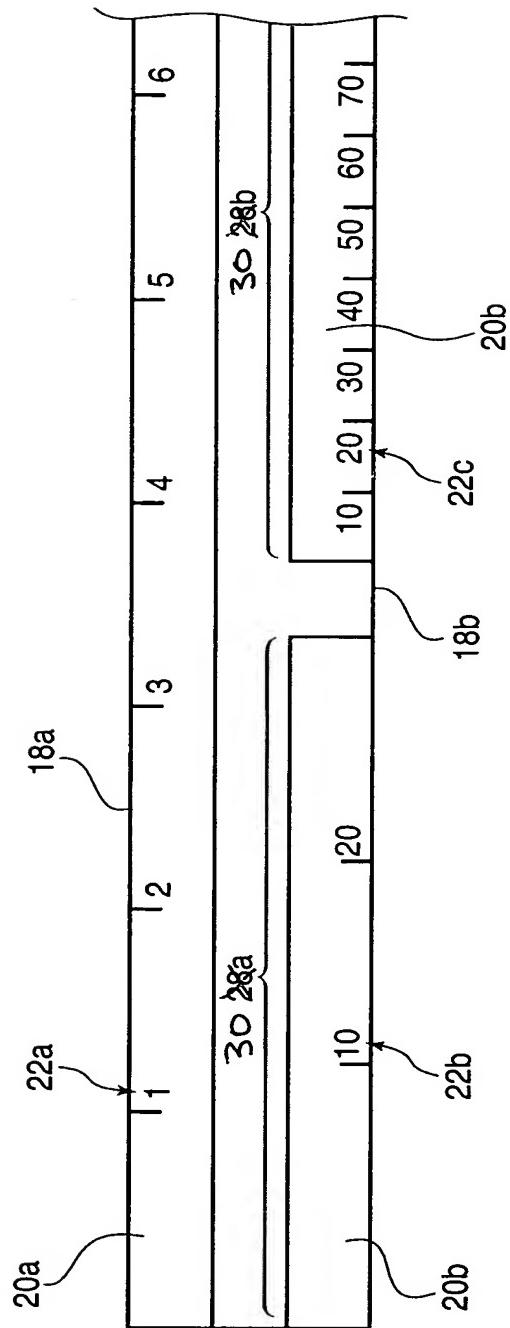


Fig. 2



3/3

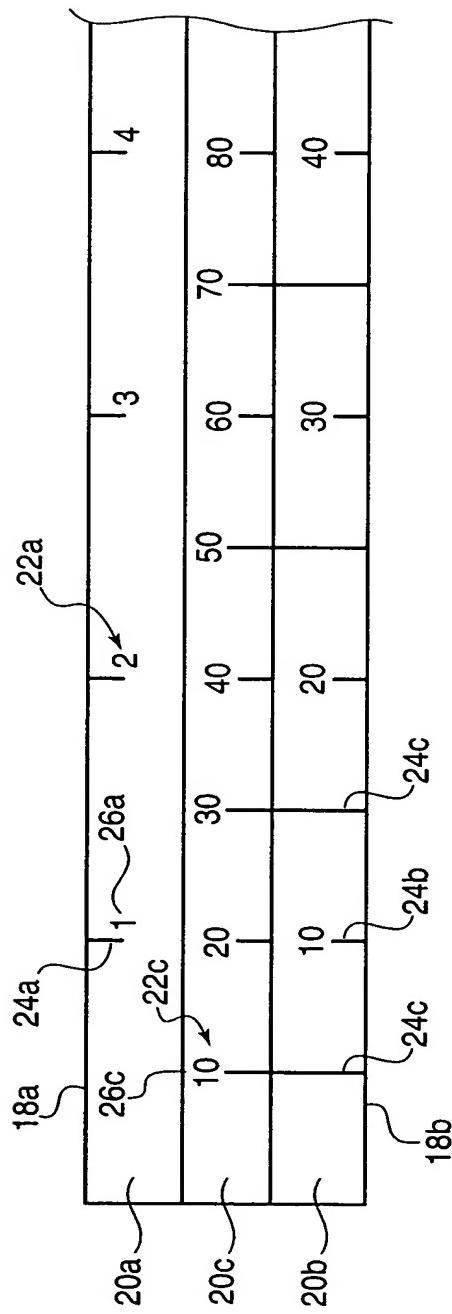


Fig. 3